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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,722	04/16/2004	Russell F. McKnight	P1910US00	1771
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GATEWAY, INC. ATTN: Patent Attorney 610 GATEWAY DRIVE MAIL DROP Y-04 N. SIOUX CITY, SD 57049			EXAMINER UBER, NATHAN C	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 12/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/826,722

**Applicant(s)**

MCKNIGHT ET AL.

**Examiner**

NATHAN C. UBER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the amendment filed on 20 August 2008.
2. Claims 1 and 10 have been amended.
3. Claims 10-18 have been added.
4. Claims 2 and 4-9 have been canceled.
5. Claims 1, 3 and 10-18 are currently pending and have been examined.

### Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 August 2008 has been entered.

### Claim Objections

7. Claims 17 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. The claims recite *the offer is not based upon the profile corresponding to the user or the profile distinction associated with the third party*, but they depend from claims 1 and 10 which recite *an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party*. The offer of claims 17 and 18 depend on the offer of claims 1 and 10 for antecedent basis, and in claims 1 and 10 the offer is based upon the profiles as shown.

**Claim Rejections - 35 USC § 112**

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claims recite *the offer is not based upon the profile corresponding to the user or the profile distinction associated with the third party*, but there is not support for this limitation in the specification. In fact the specification discloses at page 10, lines 14-28, that the offer is based on the respective profiles.

**Claim Rejections - 35 USC § 101**

10. Claims 10-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 10-16 and 18 fail to meet the above requirements because they are not tied to a second statutory class of invention and because they fail to transform underlying subject matter. The claims disclose a *computerized*

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*transaction*, but none of the steps of the method are tied to a second statutory class of invention.

No statutory elements perform the steps of the invention.

#### **Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1, 3 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 B2).

#### **Claim 1:**

Garrett, as shown, discloses the following limitations:

- *determining, by the computerized transaction system, if the computerized transaction is associated with the user or on behalf of a third party (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),*
- *aggregating, by the computerized transaction system, information associated with the transaction in a profile corresponding to the user if the computerized*

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*transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list"),*

- *aggregating, by the computerized transaction system, the information associated with the transaction in the profile corresponding to the user according to a profile distinction associated with the third party if the computerized transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving the selection list"),*

Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 3:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *determining if the profile distinction associated with the third party is already present in the profile* (see at least column 6, line 42, the list of parties can be displayed),
- *establishing the profile distinction associated with the third party if the profile distinction is not already present in the profile* (see at least column 3, lines 46-47, generating... a list of names... the customer may associate items with),
- *aggregating the information associated with the transaction in the profile distinction associated with the third party if the profile distinction is already present in the profile* (see at least column 3, lines 52-53, "saving the selection list).

**Claim 10:**

Garrett, as shown, discloses the following limitations:

- *initiating a computerized transaction with the user by the merchant for a subject using the computerized transaction system* (see at least column 6, line 16-20, log-on),
- *receiving, by the computerized transaction system, from the user an indication of whether the subject of the computerized transaction is intended for use by the user or by a third party* (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),
- *distinguishing in the computerized database system between the subject of computerized transactions by the user that is intended for use by the user and the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),

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- *aggregating the information associated with the transaction in a profile corresponding to the user if the subject of the computerized transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list"),*
- *aggregating the information associated with the transaction in a profile corresponding to the user according to a profile distinction associated with the third party if the subject of the computerized transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving the selection list"),*

Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely



would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 11:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *the presenting the offer to the user is not based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim 12:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *aggregating, in a user profile for the user in the computerized database system, information regarding the subject of computerized transactions by the user that is intended for use by the user* (see at least column 3, lines 52-53, "saving the selection list"),
- *aggregating, in the user profile for the user in the computerized database system, information regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 3, lines 52-53, "saving the selection list").

**Claim 13:**

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The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *presenting the offer to the user is based upon the aggregated information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user* see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim 14:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *the presenting the offer to the user is not based upon the aggregated information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

**Claim 15:**

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The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Garrett does not specifically disclose the following limitations. Jacobi, as shown, discloses the following limitation:

- *recommending a product to the user, the presentation of the offer being based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 16:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Garrett does not specifically disclose the following limitations. Jacobi, as shown, discloses the following limitation:

- *the recommending of the product to the user is not based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item

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selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 17 and 18:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Garrett does not specifically disclose the following limitations. Jacobi, as shown, discloses the following limitation:

- *the offer is not based upon the profile corresponding to the user or the profile distinction associated with the third party (see at least column 1, lines 51-52, offers based on collaborative filtering),*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Jacobi with the data retrieval and storage method of Garrett and provide product offers based on collaborative filtering rather than or in addition to offers based on user profiles since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Response to Arguments**

14. Examiner updated the rejection to reflect Applicant's amendments. Applicant moved the features of the dependent claim up into the independent claim. No new art was added. Applicant's arguments filed 10 November 2008 have been fully considered. The argument regarding claim rejections of claims 1, 3, 15 and 16 are not persuasive. Applicant argues that *the cited patents, and especially the allegedly obvious combination of Garrett and Jacobi set forth in the rejection of*

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*the Office action, would not lead one skilled in the art to the applicant's invention as required by claims 1 and 15.* Examiner has reviewed the rejection and updated the rejection to reflect Applicant's amendments. Examiner disagrees with Applicant's position for the reasons cited above in Examiner's rejections.

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**Conclusion**

15. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
17. Any response to this action should be mailed to:

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18. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 3622  
06 December 2008

/Arthur Duran/  
Primary Examiner, Art Unit 3622